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EXAMINER

TESLOVICH, TAMARA

ART UNIT PAPER NUMBER

2137

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,354	Applicant(s) ROBINS ET AL.	
	Examiner Tamara Teslovich	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-30 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-30 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's Amendments and Arguments filed December 19, 2005.

Claims 1, 6, 7, 9, 10, 17, 19, 21, 28-30, 33 and 36 are amended.

Claims 18 and 31 are canceled.

Claims 1-17, 19-30, and 32-36 are herein considered.

Response to Arguments

Applicant's arguments filed December 19, 2005 have been fully considered but they are not persuasive.

Applicant's amendments to claims 9, 17, 19, and 28 in response to the Examiner's 35 U.S.C. 112 rejections are accepted and the rejections to these claims are withdrawn accordingly.

Applicant's amendments to claims 17-20 in response to the Examiner's 35 U.S.C. 101 rejections fail to define an embodiment of the invention in the manner as required by 35 U.S.C. 101 and are therefore maintained and discussed below.

Applicant's initial argument concerns Audebert's failure to teach the security timer of claim 1. The Applicant cites the paragraphs cited by the Examiner in the office action previous wherein Audebert discloses the use of time intervals of a relatively long duration, usually 10 minutes or more. The Applicant goes on to argue that there is no indication that such intervals are timed. The Examiner respectfully disagrees, as it is clear from the reference that time intervals of a specific duration, hence period of time, are to be utilized, making

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specific mention of 10 minutes or longer which serves to suggest that such intervals would in fact be timed.

Applicant's next argument concerns Audebert's failure to teach the portable memory module of claim 2. In page 18 of the Applicant's arguments the Applicant cites those paragraphs cited by the Examiner in previous office actions and concludes from those sections that Audebert's card is in fact a portable module, one which appears to have both ROM and RAM memories. It is clear from these sections, and from the statements of the Applicant that the reference discloses a portable memory module.

Applicant's arguments concerning the patentability of claims 10 and 17 rely on the arguments presented in regards to claim 1 above. The Examiner upholds those arguments previous, and maintains the rejections of claims 10 and 17 accordingly.

Applicant's arguments pertaining to claims 21 and 29 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references as well as 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant's arguments pertaining to claim 23 fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define

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a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references as well as 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Therefore, based on the above arguments, the Examiner maintains the rejections as set forth in the previous office action and amended below in response to Applicant's amendments.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17, 18, and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. A claim is limited to a practical application when it produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452. Claim 17 discloses 'logic configured to' prompt and determine but fails to produce a tangible result from that logic in any way.

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Additionally, the Applicant's 'computer readable medium' when read in light of page 9 of the specification, includes a number of media which fail to fall within any of the four statutory class, those mediums including but not limited to 'propagation medium' and 'an electrical connection having one or more wires'.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16, 21, 22, 24-30, and 32-36 are rejected under 35

U.S.C. 102(b) as being anticipated by US Patent No. 5,937,068 by Yves Audebert, hereinafter referred to as Audebert.

As per claim 1, Audebert discloses a system for preventing unauthorized use of an electronic device (second unit) comprising a memory residing in the electronic device and configured to store a security file (abstract), the security file corresponding to a predefined security code (password), a security time configured to time a period of time references from activation of the electronic device (col.3 lines 43-52), and a processor configured to receive a card key, the

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card key corresponding to the predefined security code (col.4), receive an indication from the security timer after the period of time has elapsed (col.3 lines 43-52), compare the card key with the security file after the period of time has elapsed, and enable use of the electronic device only if the security file corresponds to the card key (abstract; col.4 lines 60-67).

As per claim 2, Audebert discloses wherein the card key resides in a portable memory module configured to couple to the electronic device and further configured to communicate the card key to the processor (col.7 lines 46-56; col.8 lines 2-6).

As per claim 3, Audebert discloses wherein the card key is a backup card key and resides in second memory, the second memory residing in a computer such that the card key is communicated from the second memory to the processor (col.14 lines 20-24).

As per claim 4, Audebert discloses wherein the electronic device comprises at least one selected from a group consisting of a digital camera, a personal computer, a laptop computer and a personal digital assistant (col.12 lines 20-27; col.14 lines 37-42).

As per claim 5, Audebert discloses a means for prompting users to communicate the card key to the electronic device (col.7 line 65 thru col.8 line 6).

As per claim 6, Audebert discloses wherein the security timer is a hardware component coupled to the processor and configured to communicate a signal to the processor indicating that the period of time has elapsed (col.14 lines 14-36).

As per claim 7, Audebert discloses a unit of memory configured to store the security time as logic such that the processor executes the security timer logic to time the period of time (col.14 lines 14-36).

As per claim 8, Audebert discloses a timer adjuster configured to adjust the time period of time timed by the security timer (col.3 line 30 thru col.4 line 7).

As per claim 9, Audebert discloses wherein the timer adjuster is at least one selected from a group consisting of at least one touch-sensitive button, at least one pushbutton, a touch pad display and a menu displayed on a display (col.3 line 30 thru col.4 line 7; col.7 line 65 thru col.8 line 6).

As per claim 10, Audebert discloses a method for providing security to an electronic device, the method comprising the steps of receiving a card key, the card key corresponding to the predefined security code (col.4); receiving a security key residing in a unit of memory within the electronic device, the security key corresponding to the predefined security code (abstract), comparing the card key with the security key, and enabling the use of the electronic device only if the card key corresponds to the security key (abstract; col.4 lines 60-67); and timing a time period references from activation of the electronic device such that the steps of receiving, comparing, and enabling are performed at the conclusion of the time period (col.3 lines 43-52).

As per claim 11, Audebert discloses the step of disabling the electronic device when the card key does not correspond to the security key (col.8 lines 45-48).

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As per claim 12, Audebert discloses wherein the electronic device comprises at least one selected from a group consisting of a digital camera, a personal computer, a laptop computer and a personal digital assistant (col.12 lines 20-27; col.14 lines 37-42).

As per claim 13, Audebert discloses a means for prompting users to communicate the card key to the electronic device (col.7 line 65 thru col.8 line 6).

As per claim 14, Audebert discloses the steps of communicating the activation of the electronic device to a security timer, and communicating the end of the timing period to a processor such that the processor performs the steps of receiving, comparing and enabling (col.3 lines 43-52; col.14 lines 14-36).

As per claim 15, Audebert discloses executing a security timer logic residing in a second unit of memory with a processor and beginning the steps of receiving, comparing and enabling when the time period has elapsed (col.14 lines 14-36).

As per claim 16, Audebert discloses adjusting the time period (col.3 line 30 thru col.4 line 7).

As per claim 21, Audebert discloses a system for preventing unauthorized use of a digital camera comprising a digital camera comprising a memory residing configured to store a security file (abstract), the security file corresponding to a predefined security code (password), and a processor configured to compare the card key with the security file, and further configured to enable use of the electronic device only if the security file corresponds to the card key (abstract; col.4 lines 60-67), and a portable memory module having a

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card key, the card key corresponding to a predefined security code (col.4), and the portable memory module configured to store additional information received from the camera (col.7 lines 46-56; col.8 lines 2-6).

As per claim 22, Audebert discloses wherein the portable memory module is configured to couple to the electronic device and further configured to communicate the card key to the processor (col.7 lines 46-56; col.8 lines 2-6).

As per claim 24, Audebert discloses a security time configured to time a period of time such that the processor compared the card key with the security file after the time period has lapsed (col.3 lines 43-52).

As per claim 25, Audebert discloses wherein the security timer is a hardware component coupled to the processor and configured to communicate a signal to the processor indicating that the time period has lapsed (col.14 lines 14-36).

As per claim 26, Audebert discloses a unit of memory configured to store the security time as logic such that the processor executes the security timer logic to time the time period (col.14 lines 14-36).

As per claim 27, Audebert discloses a timer adjuster configured to adjust the period of time timed by the security timer (col.3 line 30 thru col.4 line 7).

As per claim 28, Audebert discloses wherein the timer adjuster is at least one selected from a group consisting of at least one touch-sensitive button, at least one pushbutton, a touch pad display and a menu displayed on a display (col.3 line 30 thru col.4 line 7; col.7 line 65 thru col.8 line 6).

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As per claim 29, Audebert discloses a method for providing security to a digital camera, the method comprising the steps of receiving a portable memory module, the portable memory module having a card key corresponding to a predefined security code, and further configured to store additional information received from the digital camera and communicating the card key from the portable memory module to the digital camera (col.7 lines 46-56; col.8 lines 2-6), receiving a security key residing in a unit of memory within the digital camera, the security key corresponding to the predefined security code (col.4), comparing the card key with the security key and enabling the use of the digital camera only if the card key corresponds to the security key (abstract; col.4 lines 60-67).

As per claim 30, Audebert discloses the step of disabling the digital camera when the card key does not correspond to the security key (col.8 lines 45-48).

As per claim 32, Audebert discloses the step of timing a time period such that the steps of receiving, comparing and enabling are performed at the conclusion of the time period (col.14 lines 14-36).

As per claim 33, Audebert discloses the steps of communicating the activation of the digital camera to a security timer, and communicating the end of the timing period to a processor such that the processor performs the steps of receiving, comparing and enabling (col.3 lines 43-52; col.14 lines 14-36).

As per claim 34, Audebert discloses executing a security timer logic residing in a second unit of memory with a processor and beginning the steps of

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receiving, comparing and enabling when the time period has elapsed (col.14 lines 14-36).

As per claim 35, Audebert discloses the step of adjusting the time period (col.3 line 30 thru col.4 line 7).

As per claim 36, Audebert discloses prompting a user to communicate the card key to the digital camera (col.7 line 65 thru col.8 line 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,937,068 by Yves Audebert as applied to claims 1-16, 21, 22, and 24-36 above, and further in view of US Patent No. 6,044,349 by Tolopka et al.

Claim 23 refers to the system of claim 22, wherein the additional information residing in the portable memory module is information corresponding to a captured image.

Audebert refers only to the system of claim 22, wherein the additional information residing in the portable memory module is information corresponding to data representing an account balance or an account number and so on (col.11

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lines 53-56) and fails to mention wherein the information corresponds to a captured image.

Tolopka describes a secure and convenient information storage and retrieval method and apparatus comprising a portable storage medium, also referred to as a smart card, used to store data and provide access to information from an information dissemination system (Abstract). The smart card contains predefined security codes including but not limited to personal identification numbers and biometric codes which are used to authorize the holder of the card for transactions with electronic devices and such (col.3 lines 36-54). The card can also be configured to store other selected information (col.6 lines 29-35), including information corresponding to captured images such as that of the owner of the card (col.3 lines 55-65). The card also contains an adjustable timer used to limit access times (col.5 lines 38-54).

It would have been obvious to a person of average skill in the area at the time of the invention to include within Audebert's smart card the information corresponding to captured images as described in Tolopka to provide a secondary means of authentication.

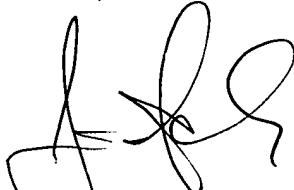
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. Teslovich
March 1, 2006



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